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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,649	08/01/2000	J. Scott Carr	60256	7630

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DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER
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PATEL, JAYANTI K

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/19/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/629,649

Applicant(s)

CARR ET AL.

Examiner

Jayanti K. Patel

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 0100.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/301,528. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites optical indicia that are obviously equivalent to a steganographer identifier associated with the mail item.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over Kara (US. 5,717,597) in view of Manduley (US. 5,650,934).

Regarding claim 1, Kara discloses a system for printing personalized postage indicia on greeting cards and envelopes comprising the steps of: reading from the article a machine-readable indicia and producing data corresponding thereto (column 6, line 66 through column 7, line 5); consulting a database record to identify physical address corresponding to at least a portion of the data (column 7, lines 43-48).

Kara discloses a typical mail processing system and is silent about the step of directing mail to physical address.

In the same field of endeavor, however, Manduley discloses secured mail producing system comprising the step of directing mail to the physical address (column 10, lines 1-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a method of directing mail to the physical address as taught by Manduley because Manduley provides a typical mail producing and franking moderately sized mail runs of a high quality and which is suitable for office environment. Additionally, the step of directing mail to the physical address is a routine function of the postal system to conform with the regulations/requirements.

As to claim 2, Kara discloses a system which includes a printer for printing physical address (figure 1B, element 19).

As to claim 3, Kara discloses a scanner (column 6, lines 65-66) which are normally comprising of rows and columns of sensing elements.

As to claim 4, while Kara is silent about the specific details regarding not having printed a textual delivery address, Kara discloses a postal system which selectively prints a plurality of information based on user selected parameters (column 16, line 61 through column 17, line 20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an envelope not having printed thereon a textual delivery address because the physical address is a redundant information and is not required as indicia on the envelope already has the address information which can be

easily ascertained by scanning the indicia by a portable scanner. Further, the process of not printing physical address reduces mail processing time and printer resources.

As to claim 5, while Kara is silent about the device used in franking the envelope, Manduley discloses the envelope having optically discernable indicia (Figure 16A, elements 1604) and the device used in franking the envelope (column 1, line 62 through column 2, line 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the optically discernable indicia and device used in franking mail envelope as taught by Manduley because Manduley provides a typical mail producing and franking moderately sized mail runs of a high quality and which is suitable for office environment. Additionally, the step of processing mail with optically discernable indicia and the envelope franking device are routine functions of the postal system to conform to the regulations/requirements.

6. Claims 6-19 are rejected under 35 U.S.C. 103(a) as being obvious over Kara (US 5,717,597) in view of Rhoads (WO 96/36163) and Ramsay et al. (US 5,502,576).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed

in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claims 6-8, Kara discloses a typical mail envelop with optical indicia (Figure 16B) without specific details representing fragile digital watermark representing plural bits of digital data to evidence scanning and printing.

In the same field of endeavor, however, Rhoads discloses digital watermark representing plural bits of digital data (pages 20 and 101) being applied as a tags to a mail item surface and Ramsay discloses a document processing system comprising fragile watermark on the document (column 8, lines 35-50) designed to evidence reproduction by scanning and printing (figure 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use fragile digital watermark as taught by Rhoads and Ramsay in the mail processing system of Kara because Rhoads and Ramsay provide Kara with a most interactive, secured and hybrid document processing system.

Such hybrid document processing system would greatly benefit Kara by providing advantages associated with analog and digital document processing (scanning, printing, transmission and storage).

Regarding claim 9, Kara discloses the step of encoding taking the form of printing the envelope (figure 1B, element 19).

Regarding claims 10-11, Kara discloses the printing designed with ink designed for sensing in the ultraviolet or infrared spectra (column 6, line 66 through column 7, line 15; also see Rhoads, figure 30).

Regarding claim 12, claim 12 substantially recites very similar limitations as claims 6-11 above and is similarly analyzed.

As to claims 13-14, Kara discloses the device updates database information and delivery confirmation to a sender (figure 3).

As to claims 15-18, while Kara is silent about the specific details regarding internet resource, Rhoads discloses the step of transmitting data produced by the device in response to optical sensing envelope to a first and receiving information from a second internet resource (figure 27, elements 1008 and 1004).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Internet resource as taught by Rhoads in the mail processing system of Kara because Rhoads provides Kara with a most interactive, secured and hybrid document processing system.



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As to claim 19, Kara discloses two machine-readable indicia conveying data associated with an authorized user (figure 16A, elements 1604 and 1608). All other limitations of claim 19 are similarly analyzed as claims 6-11 above.

***Other prior art cited***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Axelrod et al. (US 4,800,505) discloses a mail preparation system.

Hechinger et al. (US 6,029,883) discloses envelope indicia exposing postage indicia based on the front and rear portion information.

Seestrom (US 5,535,279) discloses a postage accounting system for transmitting a bit-mapped image of variable information for driving external printer.

Pastor et al. (US 5,666,421) discloses a mail-processing system including data center verification for mail pieces (figure 14).

Munduley et al. (US 5,539,190) discloses a system for secured metering of mail pieces.

Kara et al. (US 5,778,076) discloses a system for controlling the dispensing of authenticating indicia.

Walz (US 5,190,210) discloses continuous mailing forms and mailing preparation system.

Kara (US 5,666,284) discloses a system for storing, retrieving and automatically printing postage on the mail.

Copriviza et al. (US 5,319,453) discloses system for video signal encoding, decoding and monitoring.

Windel et al. (US 5,953,426) discloses a system for generating and checking a security imprint.

Cordery et al. (US 5,661,803) discloses a system for token verification in a key management system.

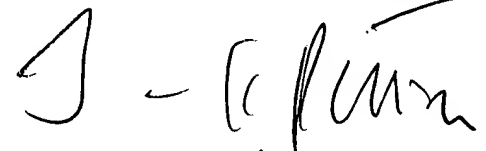
Carrell (US 4,871,903) discloses a system for rapidly accessing large postal database.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayanti K. Patel whose telephone number is (703) 308-7728. The examiner can normally be reached on Monday-Friday (7:00-4:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Jayanti K. Patel  
Primary Examiner

JKP

August 15, 2003